

REMARKS

Prior to entry of this amendment, claims 1-4, 6-11, 13-16 and 18-38 are currently pending in the subject application. By the instant amendment, the Abstract of the Disclosure is amended, the specification is amended, claims 1, 3, 4, 6, 7, 11, 13-15, 18-27, 29 and 31-38 are amended, claims 2 and 16 are cancelled, and claim 39 is added. Claims 1, 19, 25, 29, 33 and 36 are independent.

Applicants note with appreciation the Examiner's acknowledgement of applicants' claim for foreign priority and receipt of a certified copy of the priority document.

Applicants also note with appreciation the Examiner's acknowledgement and acceptance, in the Office Action Made Final mailed February 16, 2007, of the replacement drawings filed October 8, 2004. In this regard, applicants note that the outstanding Office Action Made Final, mailed March 13, 2007, replaced the February 16th Office Action Made Final. However, in the outstanding Office Action Made Final, the Examiner provided no indication as to the status of the drawings. Accordingly, applicants respectfully request that, in the next office action, the Examiner confirm the acceptability of the replacement drawings filed October 8, 2004.

Claims 1, 3, 4, 6-11, 13-15 and 18-39 are presented to the Examiner for further or initial prosecution on the merits.

A. Summary of Amendments

The Abstract of the Disclosure and three paragraphs of the Summary of the Invention section of the instant application have been amended to replace the term "wavelengths" with the term --polarizations--, in order to maintain consistency with the Detailed Description of the Invention section of the instant application. No new matter is added, and support for this amendment can be found throughout the Detailed Description of the Invention section, e.g., at paragraphs [00134]-[00137].

The claims have been broadened by the instant amendment. Accordingly, the Examiner is expressly requested to re-visit any prior art references previously considered, as applicants no longer intend to be limited to the scope of the claims as they were presented prior to entry of the instant amendment. In addition, applicants disavow any disclaimer of claim scope that may have arisen as a result of arguments previously advanced by the applicants in the instant application. *See Hakim v. Cannon Avent Group, PLC, No. 2005-1398, 2007 U.S. App. LEXIS 3926; 81 USPQ2d (BNA) 1900 (Fed. Cir. 2007).*

Applicants note that the claims have been amended to, *inter alia*, replace the term "wavelengths" with the term --polarizations--. No new matter is added, as discussed above. Claim 39 has been added. No new matter is added, as claim 39 re-presents subject matter that was recited in original claim 12, which was previously cancelled.

B. Summary of the Status of the Claims

In the outstanding Office Action Made Final, the Examiner rejected claim 13 under 35 U.S.C. § 112, second paragraph; rejected claims 1-4, 6-8, 25-28 and 33-35 under 35 U.S.C. § 101; rejected claims 1-4, 6-8, 11, 14-16 and 18-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,897,957 to Meeks et al. ("the Meeks et al. reference"); and objected to claims 9 and 10 as being dependent upon a rejected base claim, while indicating that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

C. Asserted Rejection under 35 U.S.C. § 112, Second Paragraph

In the outstanding Office action, the Examiner rejected claim 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner noted that claim 13 is dependent on claim 12, which was previously cancelled. Applicants respectfully traverse this rejection.

By the instant amendment, claim 13 is amended to change the dependency thereof, such that claim 13 depends from claim 1. Applicants respectfully submit that claim 13 is not indefinite, and respectfully request that this rejection be reconsidered and withdrawn.

D. Asserted Rejection under 35 U.S.C. § 101

In the outstanding Office Action Made Final, the Examiner rejected claims 1-4, 6-8, 25-28 and 33-35 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. Applicants respectfully traverse this rejection for at least the reasons set forth below.

By the instant amendment, claim 2 is cancelled, and independent claims 1, 25 and 33 are amended to more particularly recite aspects of the present invention. No new matter is added, and support for the instant amendment can be found in the application as originally filed, e.g., at paragraphs [0091] and [00106], and in drawing FIGS. 4 and 13.

Claims 1, 3, 4, 6-8, 25-28 and 33-35 are method claims and, accordingly, fall within the “process” category of the four enumerated categories of subject matter in 35 U.S.C. § 101. Furthermore, independent claims 1, 25 and 33 presently recite, *inter alia*, “altering a manufacturing process when the defects exceed the predetermined level,” and, thus, recite a useful, concrete and tangible result. The court in *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999) stated, “the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter.”

Further, the method recited in independent claims 1, 25 and 33 includes operations performed using a number of tangible elements, e.g., the object under inspection and a sensor or detector. Applicants respectfully submit that the recitation of these tangible elements in the claims further prevents these claims from reading on a mere abstract idea or abstract manipulation of data.

In view of the above, applicants respectfully submit that claims 1, 25 and 33, as well as the claims depending therefrom, are directed to statutory subject matter. Therefore, applicants respectfully request that this rejection be reconsidered and withdrawn.

E. Asserted Obviousness Rejection

In the outstanding Office Action Made Final, the Examiner rejected claims 1-4, 6-8, 11, 14-16 and 18-38 under 35 U.S.C. § 103(a) as being unpatentable over the Meeks et al. reference. Applicants respectfully traverse this rejection for at least the reasons set forth below.

By the instant amendment, claims 2 and 16 are cancelled, and independent claims 1, 19, 25, 29, 33 and 36 are amended. No new matter is added. Each of the independent claims recites subject matter similar to the following exemplary language recited in claim 1:

identifying types of defects in the object based on the first and second scattered lights;
...
identifying a first type of defect based on both the first scattered light and the second scattered light, and
identifying a second type of defect based on only one of the first scattered light and the second scattered light.

An example of this aspect of the present invention is described in the instant application as originally filed at paragraphs [0075]-[0082] and [0087]-[0089], in Table 2, and in drawing FIG. 4. As set forth therein, defects in the area CL4 and those in the areas CL1, CL2 and CL3 may be classified on the basis of a transition line developed from intensities of two different polarized lights.² Further, defects in the areas CL1, CL2 and CL3 may be classified on the basis of only one of the two polarized lights.³ Applicants respectfully submit that the Meeks et al. reference fails to suggest, much less disclose, this aspect of the present invention as recited in each of the independent claims.

² See, e.g., drawing FIG. 4, which illustrates voltage readings corresponding to the intensity of scattered C light (Y-axis) and scattered P light (X-axis).

³ See, e.g., drawing FIG. 4, which illustrates three regions along the X-axis that respectively correspond to the CL1, CL2 and CL3 areas.

As set forth above, applicants respectfully submit that the Meeks et al. reference fails to suggest, much less disclose, each and every element of the independent claims.

Accordingly, all of the claims in the instant application are believed to be allowable over the Meeks et al. reference. Therefore, applicants respectfully request that this rejection be reconsidered and withdrawn.

F. Allowable Subject Matter

Applicants appreciate the Examiner's indication of allowable subject matter in claims 9 and 10. However, applicants respectfully submit that all of the claims in the instant application are in condition for allowance, and a notice to that effect is respectfully requested.

G. Conclusion

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested.

Respectfully submitted,

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